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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/374,721	08/13/99	KENTEN J	IGN-2004

HM22/0920

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EXAMINER	
ZEMAN,R	
ART UNIT	**PAPER NUMBER**
1645	11

DATE MAILED: 09/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/374,721	Applicant(s) Kenten et al.
	Examiner Robert A. Zeman	Group Art Unit 1645

☒ Responsive to communication(s) filed on *Aug 13, 1999* .

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *1* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-116* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims *1-116* are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-23, drawn to fusion proteins comprising a heat shock protein to a single epitope-containing segment, the epitope-containing segment comprising two or more identical segments, classified in class 530, subclass 350 .

II. Claims 24-48, drawn to fusion proteins comprising a heat shock protein fused to two ore more non-contiguous epitope-containing segments, each epitope containing segment comprising one or more identical or non-identical self-epitopes, classified in class 530, subclass 350.

III. Claims 49-63, drawn to fusion proteins comprising a heat shock protein fused to a single epitope-containing segment comprising two or more identical or non-identical self-epitopes, classified in class 530, subclass 350.

IV. Claims 64-77, drawn to fusion proteins comprising a heat shock protein fused to a single epitope-containing segment comprising one or more identical or non-identical self-epitopes fused to the heat shock protein at the N-terminus of said heat shock protein, classified in class 530, subclass 350.

V. Claims 78-81, drawn to DNA constructs and cells containing said constructs, classified in class 435, subclass 320.1.

VI. Claims 82-96, drawn to methods of stimulating immune response using self-antigens, classified in class 424, subclass 810.

VII. Claims 97-100, drawn to drawn to methods of stimulating immune response using ubiquitin fusion proteins, classified in class 424, subclass 94.1.

VIII. Claim 101, drawn to a method of stimulating immune response using DNA constructs, classified in class 514, subclass 44.

IX. Claims 102, drawn to a method of identifying antibodies, classified in class 435, subclass 7.1.

X. Claims 103-109, drawn to methods of reducing levels of endogenous proteins using ubiquitin fusion proteins, classified in class 424, subclass 192.1.

XI. Claims 110-116, drawn to methods of reducing levels of endogenous proteins using DNA constructs, classified in class 514, subclass 44.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-IV are separate and distinct as they comprise completely differing biochemical and immunological entities having differing properties and uses. Each fusion protein differs in the composition and properties of the self-antigen portion of the molecule. Consequently, members of each group will differ in their physical and chemical properties, as well as, differing effects *in vivo.*

Inventions I-IV and V are separate and distinct as they comprise completely differing biochemical and immunological entities having differing properties and uses. Inventions I-IV are drawn to fusions proteins while Invention V is drawn to DNA constructs and cells containing said constructs.

Inventions I-IV and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case polypeptides can be used lieu of fusion proteins in the methods of Invention VI.

Inventions V and VI are separate and distinct as the DNA constructs cells Invention V cannot be used in the methods of Invention VI.

Inventions I-IV and Invention VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the fusion proteins of Inventions I-IV can be used to produce monoclonal antibodies or in binding studies.

Inventions V and VI are separate and distinct as they are drawn to differing methods having different steps and leading to differing results.

Inventions VI and VII are separate and distinct as they are drawn to differing methods having different steps and leading to differing results.

Inventions I-IV and VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the fusion proteins of Inventions I-IV can be used to produce monoclonal antibodies or in binding studies.

Inventions V and VIII are separate and distinct as the DNA constructs and cells of Invention V cannot be used in the methods of Invention VIII.

Inventions VI and VIII are separate and distinct as they are drawn to differing methods having different steps and leading to differing results.

Inventions VII and VIII are separate and distinct as they are drawn to differing methods having different steps and leading to differing results.

Inventions I-IV and IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the fusion proteins of Inventions I-IV can be used to produce monoclonal antibodies or in binding studies.

Inventions V and IX are separate and distinct as the DNA constructs and cells of Invention V cannot be used in the methods of Invention IX.

Inventions VI and IX are separate and distinct as they are drawn to differing methods having different steps and leading to differing results.

Inventions VII and IX are separate and distinct as they are drawn to differing methods having different steps and leading to differing results.

Inventions VIII and IX are separate and distinct as they are drawn to differing methods having different steps and leading to differing results.

Inventions I-IV and X are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the fusion proteins of Inventions I-IV can be used to produce monoclonal antibodies or in binding studies.

Inventions V and X are separate and distinct as the DNA constructs and cells of Invention V cannot be used in the methods of Invention X.

Inventions VI and X are separate and distinct as they are drawn to differing methods having different steps and leading to differing results.

Inventions VII and X are separate and distinct as they are drawn to differing methods having different steps and leading to differing results.

Inventions VIII and X are separate and distinct as they are drawn to differing methods having different steps and leading to differing results.

Inventions IX and X are separate and distinct as they are drawn to differing methods having different steps and leading to differing results.

Inventions I-IV and XI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the fusion proteins of Inventions I-IV can be used to produce monoclonal antibodies or in binding studies.

Inventions V and XI are separate and distinct as the DNA constructs and cells of Invention V cannot be used in the methods of Invention XI.

Inventions VI and XI are separate and distinct as they are drawn to differing methods having different steps and leading to differing results.

Inventions VII and XI are separate and distinct as they are drawn to differing methods having different steps and leading to differing results.

Inventions VIII and XI are separate and distinct as they are drawn to differing methods having different steps and leading to differing results.

Inventions IX and XI are separate and distinct as they are drawn to differing methods having different steps and leading to differing results.

Inventions X and XI are separate and distinct as they are drawn to differing methods having different steps and leading to differing results.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Zeman whose telephone number is (703) 308-7991. The examiner can be reached between the hours of 7:30 am and 4:00 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, Donna Wortman, Primary Examiner can be reached at (703) 308-1032 or the examiner's supervisor, Lynette Smith, can be reached at (703)308-3909.

DONNA WORTMAN
PRIMARY EXAMINER

Robert A. Zeman

September 19, 2000